## REMARKS

This Amendment After Final is prepared in response to the final Office action mailed on 27 September 2007 (Paper No. 20070914). Indication of allowability of claims 54 through 58, 61 through 64, and 71 through 76 over the prior art as set forth on page 5 of the Office action is noted with appreciation.

### Status of the Claims

Claims 54 through 64 and 71 through 76 are pending in the application.

Claims 1 through 53 were previously canceled without prejudice or disclaimer in the Preliminary Amendment filed with the application on 11 March 2005 and claims 65 through 70 were canceled without prejudice or disclaimer in the Amendment filed on 19 June 2007.

### Amendments to the Claims

No amendments are made to the claims in this Response.

### Objection to the Claim for Priority

The Examiner states that Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 and 365(c). Applicant claims, in paragraph [0001] of the specification, that "all benefits accruing under Title 35 U.S. Code §365(c) of my PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST),* filed on 17 July 2003 and duly assigned Serial No. PCT/US03/19560." The objection to the claim for priority should therefore be withdrawn.

For confirmation of the information relative to this application, Applicant is submitting a photocopy of Applicant's original ***Application Data Sheet under 37 C.F.R. §1.76*** which was annexed to Applicant's original specification delivered to the mailroom

of the Office.

**Specification**

The specification has been amended to indicate that the present application was filed pursuant to 35 U.S.C. §121 as a divisional of Serial No. 10/208,188 which is now patented as U.S. Patent No. 6,820,616.

It should be noted that the official Filing Receipt originally issued by the Office contains erroneous information relative to three cross-referenced patent applications, that is, PCT/US2003/019560, 10/208188 (US6820616), and 60/308846. Despite Applicant's **repeated written requests** to correct the official Filing Receipt, the Office has to date refused to issue a corrected Filing Receipt which indicate correct cross-reference information relative to the present application.

In support of this objection, and the accompanying rejection of claim 59, the Examiner asserted that,

> "Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 and 365(c) as follows:
>
> If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120 and 365, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet.
>
> For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29,2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the

> actual filing date of the application or sixteen months from the filing date of the prior application."

Applicant respectfully notes that neither 37 CFR §1.78(a) nor 37 CFR §1.78(d) impose these requirements; moreover, there is absolute not one word written by the U.S. Congress in 35 U.S.C.§121 that purports to limit Applicant's ability to seek examination of non-elected claims as a consequence of the Examining staff's imposition of a requirement under 35 U.S.C. §121. This objection, and the accompanying rejection of claim 59, are improper. Their withdrawal is respectfully urged.

**Double Patenting**

Claim 59 is rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 21 and 39 of U.S. Patent No. 6,820,616. Applicant respectfully traverses this rejection for the following reasons.

**Rejection of Claims Based On Nonstatutory Obviousness-Type Double Patenting**

**A. The Examining staff given any authority under 35 U.S.C. §121 to reject a claim filed in a divisional application under the doctrine of non-obviousness double patenting, when the applied art is "[a] patent issuing upon an application with respect to which a requirement for restriction under the section has been made," and the claim is pending in a divisional "application filed as a result of the requirement ... before the issuance of the patent on the other application?"**

Claim 59 is rejected under the doctrine of non-statutory, obviousness-type double patenting over claims 21 and 39 of Appellant's U.S. Patent No. 6.820.616 B1. In support of this rejection, the Examining staff previously argued that,

> "The limitation of a control panel with respect to Applicant's arguments against the double patenting rejection of claim 1, it is respectfully submitted that ... that applicant has been clearly shown the similarities in the corresponding claims."

Now, Paper No. 20070914 argues in an un-numbered paragraph, that,

> "the conflicting claims are not identical, they are not patentably distinct from each other because ... claim 59 **has everything as recited in the patented claim 21** including a controller. *The **only difference** is ... a control panel.* ... The limitation of a control panel is also found in the patented claim 39 ... ."

What the Examiner has improperly ignored however, is that Applicant's *Application Data Sheet 37 CFR 1.76* expressly claims, under the *Domestic Benefit/National State Information*, is in the express language of Applicant's *Application Data Sheet 37 CFR 1.76*, that accompanied the filing of Applicant's above-captioned application, is a:

> Division application of [Appellant's] Prior Application Number 10208188 filing Date 2002-07-31 Patent Number 6820616 Issue Date 2004-11-23."

In the precise language and format of the Applicant's *Application Data Sheet 37 CFR 1.76*,

**Domestic Benefit/National Stage Information:**

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78(a)(2) or CFR 1.78(a)(4), and need not otherwise be made part of the specification.

| Prior Application Status | Expired | | | | Remove |
|---|---|---|---|---|---|
| Application Number | Continuity Type | | Prior Application Number | | Filing Date (YYYY-MM-DD) |
| 10522721 | a 371 of international | | PCT/US03/19560 | | 2003-07-17 |
| Prior Application Status | Patented | | | | Remove |
| Application Number | Continuity Type | Prior Application Number | Filing Date (YYYY-MM-DD) | Patent Number | Issue Date (YYYY-MM-DD) |
| 10522721 | Division of | 10208188 | 2002-07-31 | 6820616 | 2004-11-23 |
| Prior Application Status | Expired | | | | Remove |
| Application Number | Continuity Type | | Prior Application Number | | Filing Date (YYYY-MM-DD) |
| 10522721 | non provisional of | | 60/308846 | | 2001-08-01 |

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Under the statute however,

> "A patent issuing upon an application with respect to which a requirement for restriction under the section has been made, or on an application filed as a result of the requirement, shall not be used as a reference either in the Patent and Trademark Office ... against a divisional application or against the original application or on any patent issued on either of them if the divisional application is filed before the issuance of the patent on the other application."[1]

In other words, the above-captioned application is a divisional application of U.S. Patent No. 6.820.616, and was timely filed on the 11th of March 2005 during the co-pendency of Applicant's PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST),* filed under Title 35 U.S. Code §365(c) on the 17th of July 2003 and duly assigned Serial No. PCT/US03/19560, as was claimed in Applicant's original specification,

> This application also makes reference to, incorporates the same herein, and claims all benefits accruing under 35 U.S.C. §119 from a provisional application entitled *Combined Aircrew Systems Tester (CAST)* filed in the United States Patent & Trademark Office on 1 August 2001, and there duly assigned Serial No. 60/308,846 and my U.S. patent application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST)* filed in the United States Patent & Trademark Office on 31 July 2002, and there duly assigned Serial No. 10/208,188 by that Office, which is now issued as U.S. Patent No. 6,820,616 on 23 November 2004. This application further makes reference to, incorporates the same herein, and claims all benefits accruing under Title 35 U.S. Code §365(c) of my PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST),* filed on 17 July 2003 and duly assigned Serial No. PCT/US03/19560.

Or, in the language of the now amended specification,

> This application is filed pursuant to 35 U.S.C. §121 as a Divisional of Applicant's Patent Application Serial No. 10/208,188 filed in the U.S. Patent & Trademark Office on the 31st of July 2002, which is now issued as U.S. Patent No. 6,820,616 on 23 November 2004. and assigned to the assignee of the present

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[1] 35 U.S.C. §121.

invention. All benefits accruing under 35 U.S.C. §120 from the parent application are also hereby claimed. This application also makes reference to, incorporates the same herein, and claims all benefits accruing under 35 U.S.C. §119 from a provisional application entitled *Combined Aircrew Systems Tester (CAST)* filed in the United States Patent & Trademark Office on 1 August 2001, and there duly assigned Serial No. 60/308,846 ~~and my U.S. patent application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST)* filed in the United States Patent & Trademark Office on 31 July 2002, and there duly assigned Serial No. 10/208,188 by that Office, which is now issued as U.S. Patent No. 6,820,616 on 23 November 2004~~. This application [[also]] further makes reference to, incorporates the same herein, and claims all benefits accruing under Title 35 U.S. Code §365(c) of my PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST),* filed on 17 July 2003 and duly assigned Serial No. PCT/US03/19560.

prior to the issue date of Appellant's Serial No. PCT/US03/19560. The instant, above-captioned U.S. application Serial No. 10/522.721 is a continuation of Appellant's U.S. Patent No. 6.588.243, and a divisional application of Appellant's U.S. Patent No. 6.820.616. Even the fact that such a requirement for a restriction may have been belatedly withdrawn in a subsequent Office action due to the Examiner's delayed recognition that all of the independent claims were allowable over the prior art is immaterial under the language of 35 U.S.C. §121, because Appellant had already been subjected by the Examiner to the inconvenience, delay in obtaining an issue date and the unnecessary expense concomitant to a requirement imposed under 35 U.S.C. §121. Nothing in 35 U.S.C. §121 negates the prohibition that the parent application "shall not be used as a reference either in the Patent and Trademark Office ... against a divisional application ... if the divisional application is filed before the issuance of the patent on the other application"[2] even after the Examiner purports during the course of the conclusion of the examination, to have withdrawn a requirement earlier imposed under 35 U.S.C. §121; Applicant notes that when the Examiner examines the application on the basis of the Applicant's election prior to purporting to withdraw a requirement for election of

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[2] 35 U.S.C. §121.

species, but does not expressly accord the Applicant an opportunity to add claims directed to all of the non-elected species, the "withdrawal" is in name only, and is illusory because Applicant has been denied the opportunity to present claims specifically directed to the non-elected species to the exclusion of the elected species.

This rejection is therefore, contrary to law, because the sole requirement imposed by the foregoing excerpt of 35 U.S.C. §121 has been met, namely the filing on the 11th of March 2005 of Appellant's above-captioned application during the co-pendency of Applicant's PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST),* filed under Title 35 U.S. Code §365(c) on the 17th of July 2003 and duly assigned Serial No. PCT/US03/19560, as was claimed in Applicant's original specification

Absent Congressional action to modify 35 U.S.C. §121, neither the Director nor any member of the Examining staff has the authority to belatedly overrule the action taken by the Office in imposing a requirement for restriction under 37 CFR §1.142. This rejection is therefore, not sustainable on the evidence of record.

**B. 35 U.S.C. §121 mandates an absolute prohibition (*e.g.*, *shall not* be used as a reference ... against a divisional application) of citation of Applicant's parent application to support any type of rejection of any claim in this divisional application.**

Claim 59 is rejected under the doctrine of non-statutory, obviousness-type double patenting over claims 21 and 39 of Appellant's U.S. Patent No. 6.820.616 B1. In support of this rejection, the Examining staff previously argued that,

> "The limitation of a control panel with respect to Applicant's arguments against the double patenting rejection of claim 1, it is respectfully submitted that ... that applicant has been clearly shown the similarities in the corresponding claims."

Now, Paper No. 20070914 argues in an un-numbered paragraph, that,

> "the conflicting claims are not identical, they are not patentably distinct from each other because ... claim 59 **has everything as recited in the patented claim 21** including a controller. *The **only difference** is ... a control panel.* ... The limitation of a control panel is also found in the patented claim 39 ... ."

What the Examiner has improperly ignored however, is that Applicant's *Application Data Sheet 37 CFR 1.76* expressly claims, under the *Domestic Benefit/National State Information*, is in the express language of Applicant's *Application Data Sheet 37 CFR 1.76*, that accompanied the filing of Applicant's above-captioned application, is sufficient to invoke the absolute prohibition (*e.g.*, ***shall not* be used as a reference ... against a divisional application**) of citation of Applicant's parent application to support any type of rejection of any claim in this divisional application. This rejection is therefore illegal under 35 U.S.C. §121. Its withdrawal is respectfully urged.

**C. Paper No. 20070914 fails to make a *prima facie* demonstration of obviousness of claim 59 over claims 21 and 39 of Applicant's parent application.**

Applicant again notes that claim 59 is rejected under the doctrine of non-statutory, obviousness-type double patenting over claims 21 and 39 of Appellant's U.S. Patent No. 6.820.616 B1. In support of this rejection, the Examining staff previously argued that,

> "The limitation of a control panel with respect to Applicant's arguments against the double patenting rejection of claim 1, it is respectfully submitted that ... that applicant has been clearly shown the similarities in the corresponding claims."

Now, Paper No. 20070914 argues in an un-numbered paragraph, that,

> "the conflicting claims are not identical, they are not patentably distinct from each other because ... claim 59 **has everything as recited in the patented claim 21** including a controller. *The **only difference** is ... a control panel.* ... The limitation of a control panel is also found in the patented

claim 39 ... ."

What the Examiner has improperly ignored however, is that claim 59 defines a structure that is patentably distinguishable from patent claim 21. The underlying assertion of the Examining staff that "*The **only difference** is ... a control panel ...*" is erroneous. Claim 21 defines a structure which incorporates, *inter alia*, flow sensors and pressure sensors, and pressure valves. This structure is not defined by claim 59.

Claim 59 however, defines a "control panel." This structure is nowhere defined by either patent claim 21 nor its parent claim 19. Consequently, the assertion of the Examining staff that " "*The **only difference** is ... a control panel ...*", is incorrect and false.

Claim 39, which does define a "control panel" and its operational structure, does not depend upon patent claim 21. Consequently, the assertion of the Examining staff that "The limitation of a control panel is also found in the patented claim 39 ...", is incorrect and false.

In order to make a *prima facie* demonstration of obviousness under 35 U.S.C. §103(a), "all the elements of" the pending claims must be "accounted for in the prior art relied upon in this record."[3] This differences may not be ignored in a determination of obviousness *vel non*. Withdrawal of this rejection is therefore respectfully urged.

**Allowable Subject Matter**

Claims 54 through 58, 61 through 64, and 71 through 76 are allowable over the prior art of record.

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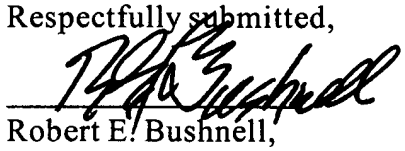
[3] *In re John B. Sullivan, et al.*, ____ F.3d ____, ____ U.S.P.Q.2d ____ (Fed. Cir. 2007).

## Conclusion

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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